REMARKS

This Application has been carefully reviewed in light of the Office Action mailed June 2, 2005. Claims 1-20 are pending in the application. In the Office Action, Claims 1-20 were rejected. For the reasons given below, Applicant respectfully requests reconsideration and favorable action in this case.

Double Patenting

The Examiner rejects Claims 1 and 10 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,650,643. Applicant has attached a Terminal Disclaimer to obviate this rejection. Applicant respectfully requests reconsideration and allowance of Claims 1 and 10.

Section 103 Rejections

The Examiner rejects Claims 1-20 under 35 U.S.C. § 103(a) as being unpatenetable by U.S. Patent No. 5,812,260 issued to Chang et al. ("*Chang*") in view of U.S. Patent No. 6,324,166 issued to Yokoyama et al. ("*Yokoyama*") and U.S. Patent No. 5,583,857 issued to Soumiya et al. ("*Soumiya*"). Applicant respectfully traverses these rejections and all assertions therein for at least the following reasons.

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. *See* 35 U.S.C. § 103(a) (2000). Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed below, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention.

The M.P.E.P. sets forth the strict legal standard for establishing a *prima facie* case of obviousness based on modification or combination of prior art references:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references where combined) must teach or suggest all the claim limitations.

M.P.E.P. chs. 2142-43 (Rev. 2, May 2004). "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. ch. 2143.03 (Rev. 2, May 2004) (citations omitted).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, "The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." M.P.E.P. ch. 2142 (Rev. 2, May 2004). The governing Federal Circuit cases are equally clear.

> A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher."

In re Kotzab, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted).

In the present application, Claim 1 recites the following limitations:

> A method for handling call set-ups in a telecommunications network, comprising:
> receiving a request to set up a call;

comparing a first load value for a switch to a load threshold for the switch;

allowing the call to be set up when the first load value is less than the load threshold;

comparing a second load value to the load threshold in response to the first load value being greater than or equal to the load threshold; and

allowing the call to be set up when the second load value is less than the load threshold.

In the Office Action, the Examiner acknowledges that *Chang* fails to teach or suggest "comparing a second load value to the load threshold in response to the first load value being greater than or equal to the load threshold." (*Office Action, Page 4*). However, the Examiner asserts that this element of Claim 1 is disclosed in *Soumiya*. *Soumiya* teaches a method for allocating calls to a transmission line. (*Abstract*). In particular, *Soumiya* describes obtaining bandwidth for a new call so that the required quality of service can be provided during the new call. (*Col. 7, lines 26-27*). To do this, *Soumiya* calculates a sum of the average cell rate for the new call and the average cell rates for all existing calls in the same traffic class as the new call. (*Col. 7, lines 27-31*). *Soumiya* then allows the new call to proceed if the total estimated bandwidth for all calls in all traffic classes is less than the physical bandwidth of the transmission line. (*Col. 7, lines 31-39*).

Even assuming, only for the sake of argument, that *Soumiya* does disclose comparing a load value to a load threshold, *Soumiya* never teaches or suggests that this is done with respect to a *second* load value *in response* to a first load value being greater than or equal to the load threshold, as recited in Claim 1. In fact, *Soumiya* expressly teaches that its single comparison step (comparing the total estimated bandwidth for all calls in all traffic classes with the physical bandwidth of the transmission line) is performed when a new call is placed. (*Step 205 of Figure 19*). As a result, *Soumiya* fails to teach or suggest Claim 1.

Furthermore, the proposed motivation to combine *Soumiya* with the other references has absolutely no support in any of the references. The Examiner asserts that it would be obvious to combine *Soumiya* with the other references to "allow a calling party to make a relatively quick decision as to how to proceed if the call is denied." (*Office Action, Page 4, First paragraph*). In *Chang* and *Yokoyama*, each system may receive a request to admit a

new communication or call, decide whether to accept or reject the request, and transmit a decision to the source that issued the request. (*Chang, Col. 12, lines 7-14; Yokoyama, Col. 8, line 61 - Col. 9, line 50*). There is no suggestion in either reference to make a second comparison if a first comparison fails. In fact, the references teach away from the proposed combination since they both teach a complete call acceptance/denial technique in which a second comparison is unnecessary and nonsensical.

The Examiner's statement that one would be motivated to combine the references to "allow a calling party to make a relatively quick decision as to how to proceed if the call is denied" does not follow based on the teachings of *Chang* and *Yokoyama*. In either reference, the calling party can either give up or try again when a call request is rejected. The teachings of *Soumiya* are in no way related to helping the calling party decide "relatively quickly" whether to hang up or try again when a call is rejected. If the Examiner chooses to maintain this rejection, Applicant respectfully requests that the Examiner explain exactly how the teachings of *Soumiya* allow a calling party decide "relatively quickly" how to proceed once a call is rejected. Furthermore, Applicants respectfully requests that the Examiner explain why this is relevant to combining the references to teach that two different load values are compared to a threshold value.

For at least these reasons, the proposed *Chang-Yokoyama-Soumiya* combination fails to teach or suggest the limitations of Claim 1. Therefore, Applicant respectfully requests reconsideration and allowance of Claim 1, as well as Claims 2-4, which depend from Claim 1.

Furthermore, independent Claim 5 requires "comparing a second load value to a second load threshold in response to the first load value being greater than or equal to the first load threshold." Independent Claim 8 requires "comparing the second dynamic load to a second threshold." These limitation are similar (although not identical) to the limitation of Claim 1 discussed above, with the primary difference from Claim 1 being that in Claims 5 and 8 the "second load value" or "second dynamic load" is compared to a *second* threshold. However, the arguments made above with respect to Claim 1 still apply to Claims 5 and 8.

Each of Claims 1, 5, and 8 recite two different comparisons. As described above, two such comparisons are not taught or suggested by the *Chang-Yokoyama-Soumiya* combination. For the same reasons, Applicant respectfully requests reconsideration and allowance of independent Claims 5 and 8, as well as Claims 6-7 and 9, which depend from Claims 5 and 8, respectively.

Claim 10 recites a system for handling call set-ups in a telecommunications network that includes:

> a load calculator operable to perform a load calculator task;
>
> a load integrator operable to calculate and store a current load value associated with a processor and operable to calculate and store an average load value associated with the processor; and
>
> a call rejection module operable to reject a request to set up a call based on the current load value and a load threshold.

The references fail to teach or suggest all elements of Claim 10. *Chang* and *Soumiya* disclose rejecting a new call when bandwidth in a communication line is not available, and *Yokoyama* discloses rejecting a new call when bandwidth in a buffer is not available. (*Chang, Col. 10, lines 43-67; Yokoyama, Abstract; Soumiya, Abstract*). None of these references deal with a current load placed on a processor or an average load placed on a processor. Also, as described above, the proposed motivation to combine the references is not supported by the references. As a result, the references fail to teach or suggest Claim 10. For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claim 10, as well as Claims 11-16, which depend from Claim 10.

Claim 17 of the present application recites an asynchronous transfer mode switch, which includes:

> a plurality of line cards, each line card operable to receive a request to set up a call; and
>
> a processing card operable to reject the request to set up the call based on a current load value associated with a processor, a load threshold associated with the processor, and an average load value associated with the processor.

As described above with respect to Claim 10, none of the cited references deal with a current load placed on a processor or an average load placed on a processor. Also, the proposed motivation to combine the references is not supported by the references. As a result, the references fail to teach or suggest the limitations of Claim 17. For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claim 17, as well as Claims 18-20, which depend from Claim 17.

CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicants respectfully request full allowance of all the pending claims.

If the present application is not allowed and/or if one or more of the rejections is maintained, Applicants hereby request a telephone conference with the Examiner and further request that the Examiner contact the undersigned attorney to schedule the telephone conference.

Although Applicants believe no fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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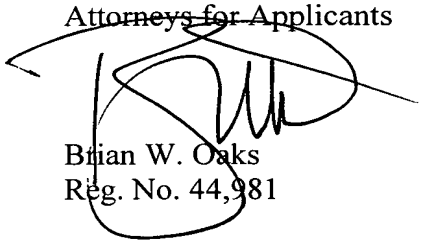

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Date: August 22, 2005

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